

REMARKS

This Amendment is submitted in response to the Office Action dated December 19, 2004. In the Office Action, the Patent Office issued a non-statutory double patenting rejection on the ground of non-statutory obviousness type double patenting over claims 1-8 of co-pending Application No. 10/680,807. The Patent Office also rejected Claim 9 and Claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Moreover, the Patent Office rejected Claims 1, 3-4, 7, 9-14 and 18 under 35 U.S.C. §102(e) as being anticipated by *Sinclair, Jr. (U.S. Patent No. 6,526,986)*. Moreover, the Patent Office rejected Claims 2, 5, 6, 8 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Sinclair, Jr.*

By the present amendment, Applicant submits herewith a terminal disclaimer to overcome the non-statutory obviousness type double patenting, and amends Claims 1, 9, 11, 13, 14 and 18. Additionally, Applicant has cancelled claim 10. Applicant submits that the terminal disclaimer and the amendments overcome the double patenting rejection, the objection to the claims and the rejection to the claims by the Patent Office.

The Patent Office rejected Claims 1-8 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-8 of co-pending Application No.: 10/680,807. The Patent Office states that "although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims fully encompass those of Application 10/680,807. The Patent Office states that a timely filed terminal disclaimer in compliance with 37 CFR §1.321(c) or 1.321(d) may be used to overcome an provisional rejection based on a non-statutory double patenting ground. Applicant submits herewith a terminal disclaimer in accordance with 37 CFR §1.321(c) to overcome the double patenting rejection. Applicant respectfully submits that the terminal disclaimer comply with 37 C.F.R. §1.321(c), and the rejection has been overcome. Notice to that effect is requested.

Moreover, the Patent Office rejected Claim 9 and Claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Patent Office alleges that Claims 9 and 10 are awkwardly worded, and it is not clear how Claim 10 further limits Claim 9. In

response to the rejection, applicant has amended Claim 9 to more particularly point out and distinctly claim the subject matter of the invention. More specifically, Claim 9 now reads "inserting a object on top of the cigar tobacco paper and using said object to assist in rolling the tobacco paper to result in said paper being in rolled form, said objection functioning to hold the shape of the tobacco paper in said rolled form". Applicant respectfully submits that the rejection under 35 U.S.C. §112 has been overcome. Notice to that effect is requested.

The Patent Office rejected Claims 1, 3-4, 7, 9-14 and 18 under 35 U.S.C. §102(b) as being anticipated by *Sinclair, Jr.* The Patent Office alleges that *Sinclair, Jr.* teaches all that is recited in the claims. (see entire document and figures) Applicant submits that the amendments to Claim 1 and Claim 9 overcome the rejection for the reasons that follow. Moreover, Applicant respectfully submits that the Sinclair patent teaches a very different apparatus and process than the present invention.

Sinclair Jr. teaches a tobacco product that is formed by rolling moistened tobacco leaves about a cylindrical form casing and allowing the leaves to dry to form a shell. After the form casing is removed, a consumer can fill the shell with crushed tobacco leaves of a favorite blend. The form casing is formed from a rigid material in a form of a cylinder. The casing is packaged with the cigar shell for shipment to the consumer. Another important element taught by Sinclair Jr. is that the shell is created, and the operator allows the shell to remain wrapped around the form casing until dry. Cutting through the wall of the shell with a sharp knife or a razor then makes the slit. (See Column 3, lines 5-8). This slit is also referred to in the claims as a longitudinal edge. The longitudinal edge portions are moved apart to open the bore. (See Claim 1 of the '986 patent)

Amended Claim 1 of the present invention requires a product for wrapping and packaging a cigar paper. The product comprises a cigar tobacco paper and an object used to keep the tobacco paper in a shape.

Moreover, amended Claim 1 requires an enveloping means wherein said enveloping means encloses the tobacco paper and further wherein the enveloping means protects said cigar tobacco paper during transit to the end consumer whereby the end consumer may unwrap the enveloping means and the cigar tobacco paper, discard the enveloping means and utilize the tobacco paper with tobacco filler.

Additionally, amended Claim 1 requires a container means for packaging the cigar tobacco paper for sending same to the consumer.

Similarly, Amended Claim 9 requires a method for packaging a cigar tobacco paper to be used by a consumer, the method comprising the steps of: providing a cigar tobacco paper to be used by the consumer to fill with tobacco filler; providing an object for placement on top of the cigar tobacco paper and using said object to assist in rolling the tobacco paper to result in said paper being in rolled form, said objection functioning to hold the shape of the tobacco paper in said rolled form; and providing an enveloping means to enclose the tobacco paper.

Sinclair Jr. does not teach or suggest a enveloping means wherein said enveloping means encloses the tobacco paper and further wherein the enveloping means protects said cigar tobacco paper during transit to the end consumer whereby the end consumer may unwrap the enveloping means and the cigar tobacco paper, discard the enveloping means and utilize the tobacco paper with tobacco filler.

On the contrary, *Sinclair Jr.* merely utilizes a casing system that is enclosed within the tobacco paper. Moreover, as illustrated in the Figures and the specification of the '986 patent, *Sinclair* requires that the tobacco be rolled, dried and a subsequent slit or longitudinal opening be cut into the tobacco before it is shipped to the end consumer. The present invention wraps the tobacco paper into a plurality of layers, wherein the end user would unwrap the tobacco paper and the enveloping means at the same time, discard the enveloping means and utilize the tobacco paper. *Sinclair Jr.* does not teach or suggest any of these elements as required by Claim 1 and Claim 9. Additionally Claim 9 requires inserting a object on top of the cigar tobacco paper and using said object to assist in rolling the tobacco paper to result in said paper being in rolled form, said objection functioning to hold the shape of the tobacco paper in said rolled form; and providing an enveloping means to enclose the tobacco paper.

Again, *Sinclair Jr.* does not teach or suggest a wrapped form and/or an enveloping means being used to enclose the tobacco paper. As illustrated in the '986 patent, *Sinclair Jr.* encloses the casing within the tobacco paper for distribution to a consumer.

Under 35 U.S.C. §102(b), anticipation requires that a single reference disclose each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

In view of the foregoing remarks and amendments, the rejection of Claims 1, 3-4, 7, 9-14 and 18 under 35 U.S.C. §102(b) as being anticipated by *Sinclair, Jr.* have been overcome and should be withdrawn. Notice to that effect is requested.

As to the rejection of Claims 2, 5-6, 8 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Sinclair, Jr.*, Applicant respectfully asserts that these claims are further believed allowable over *Sinclair, Jr.* for the same reasons set forth with respect to independent Claims 1 and 9, since each sets forth additional novel steps of Applicant's Cigar Tobacco Paper and method for packaging the same. Moreover, Applicant respectfully asserts that the amendments to Claims 1 and 9 further distinguishes the present invention from the prior art references.

Sinclair Jr. teaches a tobacco product that is formed by rolling moistened tobacco leaves about a cylindrical form casing and allowing the leaves to dry to form a shell. After the form casing is removed, a consumer can fill the shell with crushed tobacco leaves of a favorite blend. The form casing is formed from a rigid material in a form of a cylinder. The casing is packaged with the cigar shell for shipment to the consumer. Another important element taught by *Sinclair Jr.* is that the shell is created, and the operator allows the shell to remain wrapped around the form casing until dry. Cutting through the wall of the shell with a sharp knife or a razor then makes the slit. (See Column 3, lines 5-8). This slit is also referred to in the claims as a longitudinal edge. The longitudinal edge portions are moved apart to open the bore. (See Claim 1 of the '986 patent)

Sinclair, Jr. taken singly, does not teach or suggest a the apparatus or method disclosed by the applicant. More specifically, *Sinclair, Jr.* does not teach or suggest an enveloping means wherein said enveloping means encloses the tobacco paper and further wherein the enveloping means protects said cigar tobacco paper during transit to the end consumer whereby the end

consumer may unwrap the enveloping means and the cigar tobacco paper, discard the enveloping means and utilize the tobacco paper with tobacco filler as required by Claim 1

Further, the Patent Office provided no teaching as to why one having ordinary skill in the art would have been led to modify *Sinclair, Jr* to create Applicant's invention. Since the Patent Office failed to establish a *prima facie* case of obviousness, Applicant believes that the rejection of Claims 13 and 14 under 35 U.S.C. §103(a) should be withdrawn. Notice to that effect is requested.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972)

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 2, 5-6, 8 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Sinclair, Jr.* has been overcome and should be withdrawn. Notice to that effect is requested.

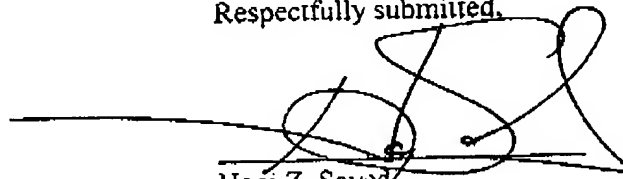
Claims 2-8 depend from Claim 1; and Claims 11-18 depend from Claim 9. These claims are further believed allowable over *Sinclair, Jr.* for the same reasons set forth with respect to independent Claims 1 and 9 since each sets forth additional novel components and steps of Applicant's cigar tobacco paper and method for packaging the same.

Request For Allowance

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any

outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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